

Appln No. 09/575,129
Amdt. Dated April 15, 2005
Response to Office action of February 18, 2005

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REMARKS/ARGUMENTS

The Office Action has been carefully considered. The issues raised are traversed and addressed below with reference to the relevant headings and paragraph numbers appearing under the Detailed Action of the Office Action.

Specification

The Applicants have amended Page 1 of the specification to correct typographical errors. The Applicants submit that these amendments do not introduce any new matter.

Claim Rejections - 35 USC § 102

The Examiner has objected to claim 1, as being anticipated by Dymetman (US 6,330,976).

Although the Applicant believes that claim 1 was previously distinct over the cited prior art, in order to obtain allowance, claim 1 of the present application has been amended to include the subject matter of claims 28, 67, and 70. Hence, claims 28, 67, and 70 have been deleted from the application and the dependent claims have been amended accordingly.

Thus, claim 1 describes that at least some of the coded data is substantially invisible to the unaided human eye, and that the invisible coded data and the visible information are printed onto the surface by means of a printer. The Applicant respectfully submits that claim 1 as revised is not anticipated by Dymetman.

In particular, Dymetman describes a method by which a coded substrate supplier produces machine-readable markings, where for example, ultra-violet ink can be used to print invisible markings on sheets of paper. Dymetman further describes that a publisher will then buy these sheets of paper and can print visible markings on them using standard ink (see column 11 lines 46 to 65), prior to the user then using these sheets of paper.

The process of having two separate entities, the supplier and the publisher, printing the invisible and visible data respectfully, is further described in the paper Dymetman, M., and Copperman, M., "Intelligent Papers", in *Proceedings of Electronic Publishing '98*, April 1998, Saint Malo, France, Springer-Verlag, 1998, pp 392-406, which is incorporated in Dymetman by reference (see column 35 lines 21 to 25). The paper describes that the "*sheets are produced by publishers, who buy apparently blank sheets of Intelligent Paper from an authorized producer. The publishers can mark them with conventional visible inks in any way they choose. For each sheet of Intelligent Paper, the infrastructure provided by the Intelligent Paper producer will ensure that, when the end-user clicks the pointer, the page-id, pointer-locpair is routed to the publisher, who is then responsible for associating whatever actions he chooses with this pair*".

Thus, the process described by Dymetman requires a supplier (or producer) to produce sheets of paper with invisible data and a publisher to print the visible data before the end-user can then use the "Intelligent Paper".

In contrast, claim 1 describes a method by which the same printer can print both the visible information and the invisible coded data. Thus, this explicitly excludes the process of Dymetman in which a first and a second printer must be used.

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Thus, claim 1 is not anticipated by Dymetman.

It will be appreciated by the Examiner that this provides significant advantages over the prior art. This allows for a user to have a printer in their home or office, and print visible information and invisible coded data on demand (see for example, page 12 lines 19 to 26, and page 51 lines 6 to 24 of the specification), on ordinary paper (see for example page 11, lines 22 to 27), without the need for a separate supplier or publisher. It will be appreciated by the Examiner that this further provides the advantages of being a more cost and time efficient process over Dymetman.

As the features of the revised claim 1 were previously in dependent claims, the Applicant submits that this does not introduce new matters for consideration.

Similar amendments have been made to independent claims 4, 82, and 86, and thus similar arguments apply.

It will be appreciated by the Examiner that none of the cited prior art documents show the printing of invisible coded data and visible information by the same printer. In particular, although some of the prior art documents describe the printing of coded data and information, both of these are visible. For example, the Examiner has asserted that Lesnick shows that a printer also prints additional information onto the surface. However, Lesnick does not describe printing coded data, which is substantially invisible to the unaided human eye.

Furthermore, even if combined with the teaching of Dymetman, there is not taught or suggested any mechanism for printing visible information and invisible coded data by the same printer.

Thus, none of the prior art documents, or combination thereof describe at least some of coded data being substantially invisible to the unaided human eye, the coded and visible information being printed onto a surface by means of a single printer. Hence, claim 1 is not anticipated by or obvious in view of any of the cited prior art documents.

Double Patenting

In view of the amendments made to the claims of the present application, the Double Patenting objections raised in the Office Action are now moot. In particular, none of the USSN 10/291,715 or USSN 10/291,543 claim printing both the visible information and the invisible coded data by the same printer. We also note that both these applications claim recording an association between an identity and a description of the interface surface. However, the Applicant submits a terminal disclaimer in compliance with 37 CFR 1.321(c) in order to overcome the nonstatutory double patenting objection with regard to claims 1, 4, 82, and 86 in view of co-pending applications USSN 10/291,715 and USSN 10/291,543.

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In light of the above, it is respectfully submitted that the objections and claim rejections have been successfully traversed and addressed. The amendments do not involve adding any information that was not already disclosed in the specification, and therefore no new matter is added. Accordingly, it is respectfully submitted that the claims 1 to 180, and the application as a whole with these claims, are allowable, and a favourable reconsideration is therefore earnestly solicited.

Very respectfully,

Applicants:



PAUL LAPSTUN



KIA SILVERBROOK

C/o:

Silverbrook Research Pty Ltd
393 Darling Street
Balmain NSW 2041, Australia

Email:

kia.silverbrook@silverbrookresearch.com

Telephone:

+612 9818 6633

Facsimile:

+61 2 9555 7762